

DETAILED ACTION

Requirement of Information under 37 CFR 1.105

Applicant is required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application:

Regarding the Paul et al. publication "Intermetallic Microlaminations for High-Temperature Microreactors" (referred to as Paul 1 in the Remarks) which applicant asserts is not a publication which qualifies as prior art, the following questions must be answered to confirm this assertion.

Per MPEP 2128 relating to "Printed Publications" as Prior Art: "A reference is proven to be a 'printed publication' "upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it." *In re Wyer*, 655 F.2d 221, 210 USPQ 790 (CCPA 1981) (quoting *I.C.E. Corp. v. Armco Steel Corp.*, 250 F. Supp. 738, 743, 148 USPQ 537, 540 (SDNY 1966)) ("We agree that 'printed publication' should be approached as a unitary concept. The traditional dichotomy between 'printed' and 'publication' is no longer valid. Given the state of technology in document duplication, data storage, and data retrieval systems, the 'probability of dissemination' of an item very often has little to do with whether or not it is 'printed' in the sense of that word when it was introduced into the patent statutes in 1836. In any event, interpretation of the words 'printed' and 'publication' to mean 'probability of dissemination' and 'public accessibility' respectively,

now seems to render their use in the phrase 'printed publication' somewhat redundant.")
In re Wyer, 655 F.2d at 226, 210 USPQ at 794."

In view of the 21st century definition of a "printed publication":

a. Was this document draft available to the public in any form? This includes any file transfer protocol (FTP) sites that the paper may have been uploaded to (within the university or the World Wide Web). Prior art disclosures on the Internet or on an on-line database are considered to be publicly available as of the date the item was publicly posted. An electronic publication, including an on-line database or Internet publication, is considered to be a "printed publication" within the meaning of 35 U.S.C. 102(a) and (b) provided the publication was accessible to persons concerned with the art to which the document relates.

See *In re Wyer*, 655 F.2d 221, 227, 210 USPQ 790, 795 (CCPA 1981)

b. Was the content of the drafted document which differs from the published version (using intermetallic lamina rather than metallic) presented in any form (such as posters, handouts, PowerPoint slides ect.) at any conferences or large lectures (greater than 50 people)?

c. Any material presented at the 4th International Conference of Micro-reaction Technology in Atlanta, GA from March 5-9 in 2000 by any of the instant inventors or authors of the paper in question is hereby requested.

d. Was the material of the drafted document which differs from the publication "known or used by others" (this includes the additional authors of the paper not listed as inventors in the current application: Tyler Dewey, David Alman or Rick Wilson). "The statutory language 'known or used by others in this country' (35 U.S.C. § 102(a)), means knowledge or use which is accessible to the public." *Carella v. Starlight Archery*, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986). The knowledge or use is accessible to the public if there has been no deliberate attempt to keep it secret. *W. L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983).

Finally in closing, per MPEP 2128 it is noted that "One need not prove someone actually looked at a publication when that publication is accessible to the public through a library or patent office. See *In re Wyer*, 655 F.2d 221, 210 USPQ 790 (CCPA 1981); *In re Hall*, 781 F.2d 897, 228 USPQ 453 (Fed. Cir. 1986)."

Conclusion

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those

documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained may be accepted as a complete reply to the requirement for that item.

This requirement is subject to the provisions of 37 CFR 1.134, 1.135 and 1.136 and has a shortened statutory period of 2 months. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas P. D'Aniello whose telephone number is (571)270-3635. The examiner can normally be reached on Monday through Thursday from 8am to 5pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica Ward can be reached on (571) 272-1223. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. P. D./
Examiner, Art Unit 1793

/Jessica L. Ward/
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